

**COPY**PATENT  
Our Docket: P-NS 4970

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

# 6

In re application of: ) Examiner: L. Chen  
Palczewski et al. )  
Serial No.: 09/990,185 ) Group Art Unit: 1632  
)  
>)  
Filed: November 21, 2001 )  
)  
For: EXPRESSION OF POLYPEPTIDES )  
IN ROD OUTER SEGMENT )  
MEMBRANES )  
\_\_\_\_\_  
Box Petition  
COMMISSIONER FOR PATENTS  
Washington, D.C., 20231

I hereby certify that this correspondence is  
being deposited with the United States  
Postal Service as first class mail in an  
envelope addressed to: Box Petition, Commissioner for  
Patents, Washington, D.C., 20231, on February 14, 2003.

By Melody E. Clark  
Melody E. Clark, Reg. No. 51,566

February 14, 2003  
Date of Signature

PETITION UNDER 37 C.F.R. § 1.181 (a) REQUESTING  
WITHDRAWAL OF HOLDING OF ABANDONMENT

Applicants petition under 37 C.F.R. § 1.181(a) that the holding of abandonment in the above-identified application be withdrawn. This petition is timely filed in accordance with 37 C.F.R. § 1.181(f).

Although a Notice of Abandonment has not yet been received, the above-identified application will be inappropriately abandoned as of December 20, 2002, for failure to respond to the Restriction Requirement mailed June 20, 2002. However, the application should not be processed as an abandoned application because Applicants did not receive the Restriction Requirement until January 8, 2003, due to an incorrect address on the Requirement. A search of the file jacket, mail log, and docket records for the above-identified application indicates that we did not receive the Restriction Requirement. For example, the last log entry on the docket record shows that

EXHIBIT A

Inventors: Palczewski et al.  
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Filed: November 21, 2001  
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Applicants recorded an Assignment on April 26, 2002, and that no petition to convert the application was filed although a PCT application was filed. A copy of the docket record for the above-identified application is attached herewith as Exhibit A. In support of non-abandonment, Applicants also submit herewith a copy of the Restriction Requirement that was received from the Examiner by facsimile on January 8, 2003 (Exhibit B), which clearly shows that the Restriction Requirement was mailed to the wrong address.

The attorney and law firm listed on the Restriction Requirement have never been associated with this application. All previous communications from the Patent and Trademark Office regarding this application have been sent to the correct address in San Diego, California. As corroboration, Applicants submit herewith a copy of the Filing Receipt (Exhibit C), Notice to File Missing Parts (Exhibit D) and Recordation of Assignment Document (Exhibit E) for this application, all sent to the correct address. Since Applicants did not receive the Restriction Requirement until after the final due date of December 20, 2002, the application should not be processed as an abandoned application.

In order to expedite processing of this application, Applicants have filed a Response to the Restriction Requirement concurrent with this Petition. A copy of the Response, filed today with the Commissioner for Patents, is attached herewith as Exhibit F.

Inventors: Palczewski et al.  
Serial No.: 09/990,185  
Filed: November 21, 2001  
Page 3

No fee is deemed necessary in connection with the filing of this petition. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-0370.

Respectfully submitted,

February 14, 2003  
Date

Melody E. Clark  
Melody E. Clark  
Registration No. 51,566  
Telephone No. (858) 535-9001  
Facsimile No. (858) 535-8949

CAMPBELL & FLORES LLP  
4370 La Jolla Village Drive  
7<sup>th</sup> Floor  
San Diego, California 92122  
USPTO CUSTOMER NO. 23601

Client: Novastis Pharmaceuticals, Inc.

## Family Name: Retinal Expression of GPCRs

Title	Serial No	Filing Date	Country	Relationship	New Status	Status	Patient No	Issue Date
EXPRESSION OF GPCRS IN RETINAL TISSUE STRUCTURE IDENTITIES	03955185	11-26-2001	United States	MEW	Pending	Pending		

Interviewer: Krzysztof I. Maj  
Witnesses: Jana

Serial No: 03955185

Date: 11-26-2001

Country: United States

Relationship: MEW

New Status: Pending

Status: Pending

Patient No:

Issue Date:

Comments: IDS has been filed. Search filing outstanding. Designation to patent to convert to prior file to a pro. Act. 11/21/2002. Filing date is 11/21/02. Pending. Sequence due 20/02/02 in Dated 10/02. Missing. Patent Sequence file 20/02/02 in Dated 10/02. It is also filed. Annexed assignment ref: J-456072. No designation to convert file. Filed original application as PCT 5493.

P2321

EXHIBIT A

4013  
JULY 1  
2003

## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
 Washington, D.C. 20591-0000  
 Telephone: 202-707-3000

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,181	11/21/2001	Kazimierz Pilczowski	P-NS 4970	1234

7390 06/10/2002

Ginger Dreyer, Esq.  
 Knobbe, Martens, Olson & Bear  
 Suite 1150  
 201 California Street  
 San Francisco, CA 94111

ORIGINAL

EXAMINER
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CHEN, LIFING

ART UNIT	PAPER NUMBER
----------	--------------

1632

DATE MAILED: 06/10/2002

4

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/990,185	FALCZEWSKI ET AL.
	Examiner Liping Chen	Art Unit 1532

The MAILING DATE of this communication appears on the cover sheet with the correspondence address.  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABDONMED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) 1-38 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s), ____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s), ____.	6) <input type="checkbox"/> Other: _____

Application/Control Number: 09/990,185  
Art Unit: 1632

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### *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-27, 30 and 36, drawn to a gene targeting construct comprising a rod outer segment (ROS) targeting signal, a vector or a cell or a gene disrupted mouse comprising the construct; classified in class 435, subclass 320.1, or class 800, subclass 13.
- II. Claims 26 and 37, drawn to a cell extract, classified in 435, subclass 325.
- III. Claims 29 and 38, drawn to a substantially purified transgenic polypeptide, classified in 530, subclass 350.

The inventions are distinct, each from the other because:

Invention I and Invention II are two mutually exclusive and independent products. The cells of invention I can be used to make transgenic mouse. The extract of invention II can be used to isolate membrane.

Invention I and Invention III are two mutually exclusive and independent products. The cells of invention I can be used to make transgenic mouse. The protein of invention III can be used to make antibody.

Invention II and Invention III are two mutually exclusive and independent products. The extract of invention II can be used to isolate membrane. The protein of invention III can be used to make antibody.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, because of their recognized divergent subject matter, and the search required for any group is not required for remaining groups, restriction for examination purposes as indicated is proper.

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Application/Control Number: 09/990,185  
Art Unit: 1632

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(h) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liping Chen, whose telephone number is (703) 305-4842. The examiner can normally be reached on Monday through Friday from 8:00 to 5:00 (Eastern Standard Time). Should the examiner be unavailable, inquiries should be directed to Deborah Reynolds, Supervisory Primary Examiner of Art Unit 1632, at (703) 305-4051. Any administrative or procedural questions should be directed to Patsy Zimmerman, Patent Analyst, at (703) 305-2758. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mail 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 308-8724.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1632.

Liping Chen, Ph.D.  
Patent Examiner  
Group 1632  
June 14, 2002

*Deborah Crouch*  
DEBORAH CROUCH  
PRIMARY EXAMINER  
GROUP 1632/630

(Click here and type address)

**FACSIMILE TRANSMISSION**

To: Rebecca McElroy Fax: 558-335-8949  
From: MS. Jacobs Date: 1/8/03  
Re: Restriction Pages: 5  
CC: Rebecca McElroy

Urgent     For Review     Please Comment     Please Reply     Please Recycle

Ms. Jacobs 703-335-3288

Notes: Select this text and delete it or replace it with your own. To save changes to this template  
for future use, choose Save As from the File menu. In the Save As Type box, choose Document  
Template. Next time you want to use it, choose New from the File menu, and then double-click  
the template.

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JAN 08 2003  
CAMPBELL & FLORES



## UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231  
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Page 1 of 2  
OK (C) (D) Pmkw

APPLICATION NUMBER	FILING DATE	GRP/ART UNIT	FIL FEE REC'D	ATTY/DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/990,185	11/21/2001	1645	0.00	P-NS 4970	2	38	3

23601  
CAMPBELL & FLORES LLP  
4370 LA JOLLA VILLAGE DRIVE  
7TH FLOOR  
SAN DIEGO, CA 92122

CONFIRMATION NO. 1224  
FILING RECEIPT



OC000000007176034

Date Mailed: 12/10/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

Krzysztof Palczewski, Residence Not Provided;  
Ning Li, Residence Not Provided;  
Juan Ballesteros, Residence Not Provided;

## Domestic Priority data as claimed by applicant

## Foreign Applications

If Required, Foreign Filing License Granted 12/04/2001

Projected Publication Date: To Be Determined - pending completion of Missing Parts

Non-Publication Request: No

Early Publication Request: No

## Title

Expression of polypeptides in rod outer segment membranes

## Preliminary Class

436

## EXHIBIT C

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LICENSE FOR FOREIGN FILING UNDER  
Title 35, United States Code, Section 184  
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related application(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



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WASHINGTON, D.C. 20591  
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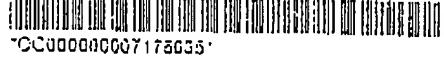
APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/990,185	11/21/2001	Krzysztof Palczewski	P-NS 4970

23601  
CAMPBELL & FLORES LLP  
4370 LA JOLLA VILLAGE DRIVE  
7TH FLOOR  
SAN DIEGO, CA 92122

DOCKETED

Rec'd due  
2-10-02

CONFIRMATION NO. 1224  
FORMALITIES LETTER



CC000000007178635

Date Mailed: 12/10/2001

## NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.63(b)

*Filing Date Granted*

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given TWO MONTHS from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. ~~RECEIVED~~ Time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

DEC 14 2001

CAMPBELL & FLORES LLP

- The statutory basic filing fee is missing.  
*Applicant must submit \$ 740 to complete the basic filing fee for a non-small entity. If appropriate, applicant may make a written assertion of entitlement to small entity status and pay the small entity filing fee (37 CFR 1.27).*
- Total additional claim fee(s) for this application is \$324.  
▪ \$324 for 13 total claims over 20.
- The oath or declaration is missing.  
*A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.*
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(l) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 1194.
- This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54804 (September 8, 2000) and 1238 OG 145 (September 18, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing", an initial paper or compact disc copy of the "Sequence Listing", as well as an amendment directing its entry into the application. Applicant must also provide a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(c), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

## EXHIBIT D

For questions regarding compliance to these requirements, please contact:

- For Rules Interpretation, call (703) 308-4216
- To Purchase PatentIn Software, call (703) 306-2600
- For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov

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*A copy of this notice MUST be returned with the reply.*



Customer Service Center  
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

APRIL 19, 2002

278

Chief Financial Officer and Chief Administrative Officer  
Washington, DC 20231  
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CAMPBELL & FLORES LLP  
CATHRYN CAMPBELL  
4370 LA JOLLA VILLAGE DRIVE  
7TH FLOOR  
SAN DIEGO, CA 92122



\*10199461SA\*

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF  
THE U. S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS  
AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER  
REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 02/11/2002

REEL/FRAME: 012601/0263  
NUMBER OF PAGES: 6

BRIEF: ASSIGNMENT OF ASSESSOR'S INTEREST (SEE DOCUMENT FOR DETAILS)

ASSIGNOR:  
PALCZEWSKI, KRYZYSZTOF

DOC DATE: 12/21/2001

ASSIGNOR:  
LI, NING

DOC DATE: 01/07/2002

ASSIGNOR:  
BALLESTEROS, JUAN

DOC DATE: 01/07/2002

ASSIGNEE:  
NOVASITE PHARMACEUTICALS, INC.  
3520 DUNHILL STREET  
SAN DIEGO, CALIFORNIA 92121

SERIAL NUMBER: 09590185  
PATENT NUMBER:

FILED DATE: 11/21/2001  
ISSUE DATE:

EXHIBIT E

RECEIVED  
APR 26 2002  
CAMPBELL & FLORES

012601/0263 PAGE 2

JEEVON JONES, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

04/07/03 MON 13:47 FAX 8585971585

CAMPBELL &amp; FLORES LLP

024

FORM PTO-1352 (National)  
 (Rev. 02-01)  
 GPO: 2001-2027, GPO: 2001-2027  
 2001-2027, GPO: 2001-2027

FEB 11 2002

Tab settings → → →

To the Honorable Commissioner of Patent

## 1. Name of conveying party(ies):

1. Krzysztof Palczewski
2. Ning Li
3. Juan Ballesteros

Z - 11 - 02

Additional name(s) of conveying party(ies)

 Yes  No

## 3. Nature of conveyance:

<input checked="" type="checkbox"/> Assignment	<input type="checkbox"/> Merger
<input type="checkbox"/> Security Agreement	<input type="checkbox"/> Change of Name
<input type="checkbox"/> Other _____	

Execution Date: 1. on 12/21/01; 2. and 3. on 01/07/02

## 4. Application number(s) or patent numbers(s):

If this document is being filed together with a new application, the execution date of the application is: \_\_\_\_\_

## A. Patent Application No.(s)

09/990,185

2/11/2002 EMBRANAL 00000022 09930165

1/FC:581

40.00 OP

Additional numbers attached?  Yes  No

## B. Patent No.(s)

## 5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Cathryn Campbell

Internal Address: CAMPBELL &amp; FLORES LLP

Street Address: 4370 La Jolla Village Drive, 7th Floor

City: San Diego State: CA ZIP: 92123

6. Total number of applications and patents involved: 

7. Total fee (37 CFR 3.41): \$ 40.00

 Enclosed - Any excess or insufficiency should be credited or debited to deposit account Authorized to be charged to deposit account

## 8. Deposit account number:

03-0370

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

## 9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Melanie K. Webster, Reg. No. 45,301

Name of Person Signing

Total number of pages including cover sheet, attachments, and document:

6

February 11, 2002

Date

Mail documents to be recorded with required cover sheet information to:  
 Commissioner of Patents & Trademarks, Box Assignments  
 Washington, D.C. 20231

JOINT

ASSIGNMENT

This Assignment is made by Krzysztof Palczewski of Bellevue, Washington, Ning Li of San Diego, California, and Juan Sallestros of Encinitas, California, Assignors, to Novasite Pharmaceuticals, Inc., Assignee, having a place of business at 3520 Dunhill Street, San Diego, California 92121.

WHEREAS, Assignors have invented a new and useful EXPRESSION OF POLYPEPTIDES IN ROD OUTER SEGMENT MEMBRANES for which an application for United States Letters Patent was filed on November 21, 2001, in the United States Patent and Trademark Office, bearing Serial No. 09/990,185 and identified as Attorney Docket No: P-NS 4970;

WHEREAS, Assignors believe themselves to be the original inventors of the invention disclosed and claimed in said application for Letters Patent; and

WHEREAS, the parties desire to have a recordable instrument assigning the entire right, title and interest in and to said invention, said application and any Letters Patent that may be granted for said invention in the United States and throughout the world;

NOW, THEREFORE, in accordance with the obligations to assign the invention and other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignors sell, assign, and transfer to Assignee, the entire right, title, and interest in and to said invention, said application, any applications entitled to benefit of priority to

Inventors: Falczewski et al.  
Serial No.: 09/990,185  
Filed: November 21, 2001  
Page 2

said application under Title 35, United States Code, Sections 120, 121 or 251, which include divisionals, continuations and reissues, and any Letters Patent that may be granted on said invention or these applications in the United States and throughout the world, including the right to file foreign applications directly in the name of the Assignee and to claim for any such foreign applications any priority rights to which such applications are entitled under international conventions, treaties, or otherwise.

Assignors agree that, upon request and without further compensation, but at no expense to Assignors, they and their legal representatives and assigns will do all lawful acts, including the execution of papers and the giving of testimony, that may be necessary or desirable for obtaining, sustaining, reissuing, or enforcing Letters Patent in the United States and throughout the world for said invention, and for perfecting, recording, or maintaining the title of Assignee, its successors and assigns, to said invention, said application, and any Letters Patent granted for said invention in the United States and throughout the world.

Assignors represent and warrant that they have not granted and will not grant to others any rights inconsistent with the rights granted herein.

Assignors authorize and request that any United States or foreign Letters Patent granted for said invention, whether on said application or on any subsequently filed divisional,

Inventors: Palczewski et al.  
Serial No.: 09/990,165  
Filed: November 21, 2001  
Page 3

continuation or reissue application, be issued to Assignee, its successors and assigns, as the assignee of the entire interest in said invention.

IN WITNESS WHEREOF, Assignors have executed this Assignment on the date(s) provided below.

Assignor: Krzysztof Palczewski

K. Palusz Dec 21 / 2001  
Signature Date

STATE OF Washington )  
COUNTY OF King )

On 12/21/01, before me,                         , personally appeared Krzysztof Palczewski, personally known to me - OR - proved to me on the basis of satisfactory evidence to be the person(s) whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

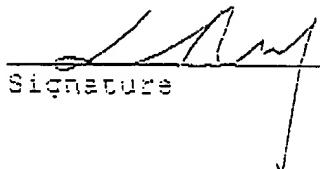
WITNESS by hand and official seal.

Melvin Wong  
(Signature of Notary)

Commission expires May 29, 2003

Inventors: Palciewski et al.  
Serial No.: 09/690,186  
Filed: November 21, 2001  
Page 4

Assignor: Ning Li

 Signature

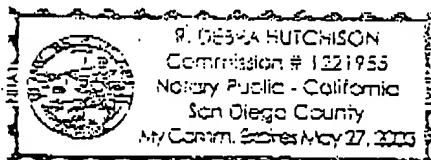
Jan. 7, 2002 Date

STATE OF California  
COUNTY OF San Diego

On January 7, 2002, before me, R. Debba Hutchinson,  
personally appeared Ning Li,  
 personally known to me - OR - proved to me on the basis  
of satisfactory evidence to be the person(s) whose name(s) is/are  
subscribed to the within instrument and acknowledged to me that  
he/she/they executed the same in his/hers/their authorized  
capacity(ies), and that by his/hers/their signature(s) on the  
instrument the person(s), or the entity upon behalf of which the  
person(s) acted, executed the instrument.

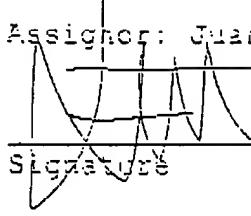
WITNESS by hand and official seal.

R. Debba Hutchinson  
(Signature of Notary)



Inventors: Palczewski et al.  
Serial No.: 09/990,183  
Filed: November 21, 2001  
Page 5

Assignor: Juan Ballesteros

  
Signature

JAN 7, 2002

Date

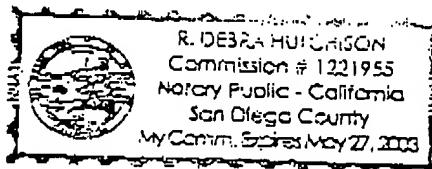
STATE OF California )  
COUNTY OF San Diego )

On January 7, 2002, before me, R. Debra Hutchinson,  
personally appeared Juan Ballesteros,  
 personally known to me - OR - proved to me on the basis  
of satisfactory evidence to be the person(s) whose name(s) is/are  
subscribed to the within instrument and acknowledged to me that  
he/she/they executed the same in his/her/their authorized  
capacity(ies), and that by his/her/their signature(s) on the  
instrument the person(s), or the entity upon behalf of which the  
person(s) acted, executed the instrument.

WITNESS by hand and official seal.

R. Debra Hutchinson

(Signature of Notary)



PATENT  
Our Docket: P-NS 4970

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of ) Conf. No.: 1224  
Palczewski et al. )  
Serial No: 09/990,185 ) Group Art Unit: 1632  
Filed: November 21, 2001 ) Examiner: L. Chen  
For: EXPRESSION OF POLYPEPTIDES) I hereby certify that this correspondence  
IN ROD OUTER SEGMENT ) is being deposited with the United States  
MEMBRANES ) Postal Service as first class mail in an  
envelope addressed to: Commissioner for  
Patents, Washington, D.C., 20231 on  
February 14, 2003.

Commissioner for Patents  
Washington, D.C. 20231

By: Melody E. Clark  
Melody E. Clark, Reg. No. 51,566

February 14, 2003  
Date of Signature

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the Restriction Requirement mailed June 20, 2002, consideration of the following Remarks is respectfully requested. A response to the Restriction Requirement was originally due December 20, 2002. However, Applicants did not receive the Restriction Requirement until January 8, 2003, because the original Restriction Requirement had been sent to the wrong address. Applicants are concurrently submitting a Petition under 37 C.F.R. 1.181(a) Requesting Withdrawal of Holding of Abandonment, attached herewith as Exhibit A. Accordingly, this Response is being timely filed.

REMARKS

Claims 1-38 are pending. The Examiner alleges that the claims are directed to three distinct and independent inventions as follows:

EXHIBIT F

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Group I: Claims 1 through 27, 30 and 36, directed to a gene targeting construct comprising a rod outer segment (ROS) targeting signal, a vector or a cell or a gene disrupted mouse comprising the construct;

Group II: Claims 28 and 37, directed to a cell extract;  
and

Group III: Claims 29 and 38, directed to a substantially purified transgenic polypeptide.

Applicants believe there is a typographical error in the Restriction Requirement regarding the claims listed in Group I. The Restriction Requirement currently states that Group I includes "claims 1-27, 30 and 36," however, we believe the Restriction Requirement intended to state that Group I includes "claims 1-27 and 30-36." Applicants believe the Examiner intended for Group I to include claims 30 through 36 because claims 31-35, which depend on claim 30, are parallel to claims 18-22 in Group I. In addition, in the current version of the Restriction Requirement, claims 31-35 are not assigned to any group. Applicants therefore interpret Group I as containing claims 1 through 27, and 30 through 36. If Applicant's interpretation of Group I is incorrect, then clarification by the Examiner and issuance of a revised Restriction Requirement is respectfully requested.

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Page 3

Applicants traverse the Restriction Requirement for the reasons stated below. Nevertheless, in order to be responsive to the Office Action, Applicants elect the claims of Group I, claims 1 through 27, and 30 through 36, directed to a gene targeting construct comprising a rod outer segment (ROS) targeting signal, a vector or a cell or a gene disrupted mouse comprising the construct. Applicants reserve the right to pursue prosecution of the non-elected claims in a later filed application claiming the benefit of priority of the above-identified application.

Applicants traverse the Restriction Requirement with respect to the division of the claims of Groups II and III from the claims of Groups I. Applicants submit that, while the claims of Groups II and III are patentably distinct from the claims of Group I, a thorough search of the elected claims of Group I will necessarily include a search of the claims of Groups II and III because the claims of Groups II and III depend on the claims of Group I. For example, a search of Group I claim 27 directed to a rod cell will necessarily include a search of Group II claim 28, directed to an extract of the cell of claim 27. In addition, a search of Group I claim 27 will necessarily include a search of Group III claim 29, directed to a substantially purified transgenic polypeptide isolated from the cell of claim 27, or from an extract thereof. Accordingly, Applicants submit that search and examination of Groups II and III with Group I does not pose a serious burden to the Examiner.

Moreover, the claims of Groups II and III, while patentably distinct from the claims of Groups I, are related such that the division of the claims into three separate groups will

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result in a duplicative effort by the U.S. Patent and Trademark Office. Since joint examination of claims 1-38 will not result in a serious burden on the Examiner, rejoinder of Groups II and III with Group I, respectfully is requested.

CONCLUSION

Applicants appreciate the Examiner's reconsideration of the Restriction Requirement. The Examiner is invited to contact the undersigned agent or Cathryn Campbell if there are any questions regarding this application.

Respectfully submitted,

February 14, 2003  
Date

Melody E. Clark

Melody E. Clark  
Registration No. 51,566  
Telephone No. (858) 535-9001  
Facsimile No. (858) 535-8949

CAMPBELL & FLORES LLP  
4370 La Jolla Village Drive  
7<sup>th</sup> Floor  
San Diego, California 92122  
USPTO CUSTOMER NO. 23601

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McDermott, Will &amp; Emery

4370 La Jolla Village Drive, Suite 700  
San Diego, California 92122  
Telephone: (858) 535-9001  
Facsimile: (858) 535-8949

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TO: Examiner Angel

Fax No.: 703.746.7182

FROM: Melody E. Clark  
Registration No: 51,556

REFERENCE: Serial No.: 09/990,185

Filed: November 21, 2001

Entitled: EXPRESSION OF POLYPEPTIDES IN ROD  
OUTER SEGMENT MEMBRANES

OUR REFERENCE: P-NS 4970

○

DATE: April 7, 2003

NO. OF PAGES (Including this page): 33

**LIST ALL DOCUMENTS BEING TRANSMITTED:**

1. Post Card for Response to the Restriction Requirement: (1 page)
2. Transmittal Form for Response to the Restriction Requirement (2 pages)
3. Response to the Restriction Requirement with attached Exhibits (29 pages)

**SPECIAL INSTRUCTIONS:**

Please deliver this INFORMAL COMMUNICATION to EXAMINER Angel.

Please do not enter this transmission as part of the PTO file.

Please contact Lisa Oliver at (858) 535-9001 if you DO NOT receive all pages.

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Please acknowledge receipt of the accompanying:  
 Response to Restriction Requirement mailed June 20, 2002 with  
Exhibit A

Other \_\_\_\_\_  
 Transmittal form 1083(in duplicate)  
 Petition for \_\_\_\_ month Extension of Time (in duplicate)  
 Applicant's Name Palczewski et al.  
 Serial Number 09/990,185 Filing Date November 21, 2001  
 Examiner's Name L. Chen Group Art Unit 1632  
 Title EXPRESSION OF POLYPEPTIDES IN ROD OUTER SEGMENT MEMBRANES  
 Fee \$ \_\_\_\_\_ Enclosed  Check No.: \_\_\_\_\_  
 Certificate of Mailing - 1st Class Date Mailed: February 14, 2003  
 Our Docket No.: P-NS 4970 Date Due: \_\_\_\_\_  
 Client Novasite  
 Attorney/Secretary MEC/cmq

Place your receiving date stamp hereon and return this card.

FORM UA Amend/Resp

Please acknowledge receipt of the accompanying:

Response  
 Other Petition Under 37 C.F.R. §1.181(a) Requesting Withdrawal  
of Holding of Abandonment with Exhibits A, B, C, D, E and F  
 Transmittal form (in duplicate)  
 Petition for \_\_\_\_ month Extension of Time (in duplicate)  
 Applicant's Name Palczewski et al.  
 Serial Number 09/990,185 Filing Date November 21, 2001  
 Examiner's Name L. Chen Group Art Unit 1632  
 Title EXPRESSION OF POLYPEPTIDES IN ROD OUTER SEGMENT MEMBRANES  
 Fee \$ \_\_\_\_\_ Enclosed  Check No.: \_\_\_\_\_  
 Certificate of Mailing - 1st Class Date Mailed: February 14, 2003  
 Our Docket No.: P-NS 4970 Date Due: \_\_\_\_\_  
 Client Novasite  
 Attorney/Secretary MEC/cmq

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